

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOUICHI TANAKA

Appeal No. 98-1033
Application No. 08/574,330¹

ON BRIEF

Before McCANDLISH, MEISTER, and STAAB, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 4 and 6.²

¹Application for patent filed December 18, 1995.

²Finally rejected claim 5 has been canceled.

The Invention

Appellant's invention pertains to an improvement to a metallic baseball bat. Conventional metallic baseball bats (see Prior Art Figure 2) include annular polishing streaks 11 on the barrel of the bat, which, according to appellant, lower adherence between the ball and the bat, so that adherence between the ball and the bat is decreased. Appellants contend that this results in decreased spin being imparted to the ball, which in turn leads to decreased flying distance (specification, paragraph spanning pages 1 and 2).

Appellant's solution to this alleged problem is to orient the polishing streaks longitudinally along the barrel of the bat (see Figure 1). Appellant asserts that orienting the polishing streaks longitudinally has the opposite effect, namely, minimizing slippage between the ball and the bat, and providing greater adherence between the ball and the bat. This, according to appellant, allows spin to be more easily imparted to the ball, resulting in increased flying distance

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(specification, page 2). Independent claim 4 is illustrative of the appealed subject matter and reads as follows:

4. A metallic ball bat comprising:
a metal handle section; and
a metal barrel section extending from said handle section, wherein a plurality of longitudinal polishing grooves are formed in an exterior surface of said metal barrel section.

The Prior Art

The following references of record are relied upon by the examiner in support of a rejection under 35 U.S.C. § 103:

Gubbins 1905	805,132	Nov. 21,
Easton et al. (Easton) 1979	4,177,989	Dec. 11,
Carr 16, 1988	4,763,900	Aug.

Easton discloses a metallic baseball bat. Easton is silent as to the presence or absence of polishing grooves on the barrel of the bat.

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Gubbins pertains to a baseball bat "to lessen the hitting of fouls by the batsmen" (lines 9-10). Gubbins states (lines 10-39):

To effect this object, a sleeve of corrugated rubber fabric is placed upon the striking or body portion of the bat and serves to prevent the glance or angular rebound of the ball by which fouls are produced.

. . .

. . . The body [of the bat] is covered with a sleeve consisting of an inner layer of cloth known as "friction-cloth," as indicated at 8, and an outer layer of corrugated rubber, (indicated at 9,) the corrugations extending lengthwise of the bat. The cloth is cemented or otherwise suitably fastened to the bat and holds the rubber firmly in place.

In the case of this bat the corrugations contact with the ball and tend to hold it from the lateral

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bound which causes fouls and to impel it in a straight and fair direction on a line. The knocking of fouls and high flies is thus prevented in a measure.

Although the invention as shown and described has a rubber cover, the same idea may be applied by the use of corrugated leather or other material.

Carr discloses a baseball bat having a roughed striking surface. More specifically, Carr provides surface roughening characteristics that promote the tendency of the ball to spin when struck off-center or struck a glancing blow. This promotion of spin enhances the tendency of the ball to deviate from its expected flight path when struck off-center (column 1, lines 6-19). According to Carr, this enhanced tendency of the ball to deviate from its expected flight path may be used, for example, by batters and coaches in the analysis and improvement of batting skills by making the batter and coach more aware of striking the ball off-center (column 1, lines 51-66).

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The Rejection

Claims 4 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Easton in view of Gubbins and Carr.

The examiner's rationale in rejecting the claims is found on page 2 of the final rejection and reads as follows:

Easton discloses the claimed bat with the exception of the longitudinal grooves. However, as disclosed by Gubbins it is known in the art to provide bats with a streaked surface for the purposes espoused by the applicant. Furthermore, as Carr teaches[,] it is known in the art to provide such grip enhancing grooves directly on the bat surface. It would have been obvious to one of ordinary skill in the art to have provided Easton's bat with a streaked surface directly on the bat as well for the reasons espoused by Gubbins and Carr.

Opinion

The key question, in our view, is what one of ordinary skill in the art would have derived from Gubbins. On the one hand, it appears that the examiner regards Gubbins as teaching that the provision of longitudinal grooves *alone* would be sufficient to bring about Gubbins objective of holding the ball from lateral bounds which causes fouls. On the other hand, appellant has taken the position that

[t]he intended purpose of the Gubbins sleeve is to contact and hold the ball in order to reduce fouls, and not to enhance the spin which is imparted to the ball. The materials selected for the sleeve [of Gubbins] are intended to be softer than the underlying bat surface which is formed of wood. It is submitted that, even at the time of the Gubbins invention, it would have been possible to form grooves in the surface of a wooden bat. However, this would not have served the intended purpose of the Gubbins invention. [Brief, page 5.]

Thus, appellant reads Gubbins as teaching that the *material* of the sleeve, as well as its longitudinal grooves, are of importance in achieving the Gubbins' objective of lessening the hitting of foul balls.

We think the appellant's view of Gubbins is the better one. Gubbins' objective is to hold the ball to the bat to prevent it from bounding away laterally. To achieve this objective, Gubbins teaches providing a corrugated *rubber* or corrugated *leather* sleeve over the hitting surface of an "ordinary" (presumably wooden) bat. In our view, one of ordinary skill in the art would have logically concluded from this that the relatively soft nature of the sleeve plays a role in achieving Gubbins purpose.³ This being the case, we do not believe the ordinarily skilled artisan would have discarded Gubbins' soft sleeve in adapting a modern metallic bat for Gubbins' purpose. Nothing in Carr convinces us otherwise. Thus, we do not regard the combined teachings of

³While we appreciate that Gubbins also states that "other materials" (lines 38-39) may be used, we do not think this disclosure is particularly helpful to the examiner's position when read in context.

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the applied references as suggesting the provision of longitudinally oriented polishing grooves on the exterior surface of a metallic bat, as now claimed.

In approaching the question of obviousness, it is improper to consider the references in less than their entireties, i.e., to disregard disclosures in the references that diverge from and teach away from the invention at hand. *W. L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1540, 220 USPQ 303, 311 (Fed. Cir. 1983). Further, it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). In our opinion, this is precisely what the examiner has done in arriving at his conclusion that the subject matter of the appealed claims would have been obvious to one of ordinary skill in view of the teachings of the applied references.

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In light of the foregoing, we cannot sustain the
examiner's rejection.

The decision of the examiner is reversed.

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No period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

REVERSE

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
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